

REMARKS

Applicants respectfully request reconsideration of the present application.

I. Disposition of the Claims

Claims 41, 53, & 67-81 are pending.

Claims 1-40, 42-52 & 54-66 have been cancelled without prejudice or disclaimer.

Claims 67-81 are new and multiply dependent. The new claims correspond to the elected invention. See cancelled claims 56, 57, and 60. These claims also seem to have been examined. See Office action of May 29, 2007, p. 9.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

II. Traversal of Communication of Non-Responsive Amendment.

A Communication dated November 30, 2007, stated that the previously filed amendment was non-responsive, because the current claim set is patentably distinct from the invention originally claimed for the following reasons: "Applicant's election with traverse of claims 41, 50, 53-60, and 65 drawn to a cosmetic composition and method of making ... in the reply filed on November 6, 2006, was acknowledged in the office action dated May 29, 2007. New claims 67-81 are drawn to method of use claims." Communication, p. 1. The full statement is reproduced as follows:

The reply filed on August 29, 2007 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Newly submitted claims 67-81 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicant's election with traverse of claims 41-50, 53-60 and 65 drawn to a cosmetic composition and method of making said cosmetic composition in the reply filed on November 6, 2006 was acknowledged in the office action dated May 29, 2007. New claims 67-81 are drawn to method of use claims.

The inventions of the cancelled claims and new claims 67-81 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using that product, such as in Guillon U.S. Patent No. 4,386,067 drawn to unsaponifiable components of avocado oil and soya bean oil in a cosmetic composition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 67-81 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Friday from 8:00 A.M. - 4:30 P.M..

Communication, p. 1. A more careful reading of the file history reveals a different set of facts.

Before October 6, 2006, the application contained, among other claims and most relevantly, claims 41 and 53 as shown below:

41. (New) A cosmetic composition for skin comprising:

at least one unsaponifiable component from avocado oil;

at least one unsaponifiable component from soya bean oil, lupin oil, or mixtures thereof; and

at least one cosmetically acceptable vehicle for applying the composition to skin.

53. (New) A cosmetic treatment for scars comprising applying the composition of claim 41 to skin, neighboring mucous membranes, superficial body growths, or a combination thereof.

Preliminary Amendment dated July 15, 2003, p. 5.

On October 6, 2006, the Examiner made requirements for election/restriction as follows:

- I. Claims 41-50, 53-60 and 65, drawn to a cosmetic composition and method of making said cosmetic composition, classified in class 424, subclass 401.
- II. Claims 51, 52 and 61-64, drawn to a cosmetic composition, classified in class 424, subclass 764.

Office action dated 10-06-2006, p. 2. The Examiner grouped claims 41 & 53 in Group I.

On November 6, 2006, the claims of Group I were elected with traverse (pp. 6-7), and claim 41 was amended to fix a typographical error. Claims 41 & 53 read as follows:

41. (Currently Amended) A cosmetic composition for skin ~~comprising;~~
comprising:
at least one unsaponifiable component from avocado oil;
at least one unsaponifiable component from soya bean oil, lupin oil, or mixtures thereof; and
at least one cosmetically acceptable vehicle for applying the composition to skin.

53. (Previously Presented) A cosmetic treatment for scars comprising applying the composition of claim 41 to skin, neighboring mucous membranes, superficial body growths, or a combination thereof.

Amendment dated November 6, 2006, pp. 2 & 4.

On May 29, 2007, claims 41 & 53 were examined, as indicated in the following:

Disposition of Claims

- 4) ☒ Claim(s) 41-66 is/are pending in the application.
- 4a) Of the above claim(s) 51, 52, 61-64 and 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-50, 53-60 and 65 is/are rejected.

Office action dated May 29, 2007, p. 1, and claim 53 was rejected as indicated in the following:

Regarding claims 53, 56, 57 and 60 drawn to treatment of scars and depilatory treatment, Guillon teaches the composition of unsaponifiable avocado oil and unsaponifiable soya bean oil for skin treatments. Rancurel teaches that unsaponifiable avocado oil treats the onset of skin aging. Since the method of treatment of scars and the method of cosmetic depilatory treatment only requires an application to the skin, the prior art renders the claims obvious. It is not claimed that the skin has a scar or the skin is hirsute. It is therefore reasonable to conclude that the strength of correlation between references gives rise to reasonable expectation of success from combining them.

Office action, p. 9.

On August 29, 2007, a response was filed incorporating the Examiner's point that she interpreted the claims as not requiring the skin to have a scar or to be hirsute. For example, claim 53 (Previously Presented) was canceled and replaced with claim 67 (New).

Claims 67-81 are new and multiply dependent. The new claims correspond to the elected invention. See cancelled claims 53, 56, 57, and 60. These claims also seem to have been examined. See Office action of May 29, 2007, p. 9.

Claims 53 (as currently amended to show the limits of independent claim 41) & 67 (new, because it was not entered) are shown side by side in the following table:

Table 1. Previously examined and rejected claim 53 versus new claim 67.

53. (Currently Amended) A cosmetic treatment for scars comprising applying the <u>a</u> composition of claim 41 to skin, neighboring mucous membranes, superficial body growths, or a combination thereof,	67. (New) A method for treating a scar comprising applying to the skin, neighboring mucous membrane, and/or superficial body growth of a patient in need thereof an effective amount of a
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<u>Wherein the composition comprises</u>	composition comprising:
<u>at least one unsaponifiable component from avocado oil;</u>	at least one unsaponifiable component from avocado oil;
<u>at least one unsaponifiable component from soya bean oil, lupin oil, or mixtures thereof; and</u>	at least one unsaponifiable component from soya bean oil, lupin oil, or a mixture thereof; and
<u>at least one cosmetically acceptable vehicle for applying the composition to skin.</u>	at least one cosmetically acceptable vehicle for applying the composition.

It is respectfully submitted that the bolded term in claim 67 (***of a patient in need thereof***) responds to the Examiner's statement that "[i]t is not claimed that the skin has a scar ..." Office action, p. 9 (shown above).

Furthermore, the Communication fails to acknowledge that claim 53 was part of the elected Group I, notwithstanding the fact that the images reproduced from the PTO's Image File Wrapper and shown above clearly indicate otherwise. Claim 53 was part of Group I, examined, and rejected. The present Communication fails to address the differences between examined and rejected claim 53 and the non-entered version of claim 67. The refusal to enter the amendment is improper and should be withdrawn.

No adverse reductions of PTA should be imposed against the present application.

III. Why this amendment should be entered regardless of the decision concerning the Communication.

In an abundance of caution, the present amendment contains claim 53 as it was examined and rejected. The amendment to claim 53 merely incorporates the base independent claim's elements. This claim is believed patentable, because the term *scars* is believed to limit the *skin, neighboring mucous membranes, superficial body growths, or a combination thereof* as recited

in claim 53. *Cf.* M.P.E.P. § 2111.03 (standing for arguing that an element in a preamble has weight means the preamble is given weight (citing *Catalina Mktg. Int'l v. Coolsavings.com*)).

In a further abundance of caution, the present amendment contains claim 41 was amended to further recite the following:

wherein the at least one unsaponifiable component from avocado oil is chosen from dry avocado oils, **{claim 42}**

wherein the unsaponifiable component from soya bean oil, lupin oil, or mixtures thereof comprises about 40% to about 65% sterols and greater than about 10% tocopherols, **{claim 46}**

wherein the cosmetic composition has a weight ratio of the unsaponifiable component from avocado oil to the unsaponifiable component from soya bean oil, lupin oil, or mixtures thereof of about 0.1 to about 9, and **{claim 47}**

wherein the unsaponifiable component from avocado oil and the unsaponifiable component from soya bean oil, lupin oil, or mixtures thereof comprise about 0.1% to about 10% of the composition by weight. **{claim 48}**

Exemplary support is shown between the brackets. This claim is believed patentable, because the cited references do not describe nor teach such a composition.

IV. General Comments

The remainder of the response has not been substantively altered from the version filed August 29, 2007.

V. Priority

The Examiner noted that the present application claims the priority benefit of an earlier-filed foreign application, and that a certified copy to foreign priority application must be in the file. Office action, pp. 2-3. The Examiner has already acknowledged a certified copy of the priority document is in the present file as noted in the Office action of October 6, 2006, p. 1. Applicants are unsure, and wish that the Examiner would clarify this position. Furthermore,

please note that this application is a divisional of application No. 09/868,989, which is the national phase of an international application which contained the priority document. See PCT/FR99/03272, filed December 23, 1999. The Examiner is referred to MPEP § 1893.03(c).

A. *Information Disclosure Statement*

The Examiner noted that documents A6-A9 and A15-A16 were not considered. Office action, p. 3. The Examiner is notified that the present application has a sibling, namely, application no. 10/619,905 filed July 15, 2003, which claims the benefit of application no. 09/868,989, which is the national stage of PCT/FR99/03272 filed December 23, 1999. The information disclosures in each case are believed parallel in the sense that the information disclosed in the parent is also disclosed in each child and that the information disclosed in each sibling is (or will be) the same. The Examiner is asked to review the parent and/or sibling file wrapper on PAIR if the Examiner deems that such a review is appropriate or needed.

Copies of documents A6-A9 listed in the Information Disclosure Statement filed October 21, 2003, in the present application, were submitted to the PTO in parent application No. 09/868,989, filed 6/22/2001. As provided in 37 CFR § 1.98(d), copies of the documents were not provided since they were previously submitted to the United States Patent and Trademark Office in the above-identified parent application. Courtesy copies of these references are filed herewith for the Examiner's convenience and consideration. These documents are listed on the presently filed SB08. Documents A15-A16 are also listed on the SB08.

As noted on the original SB08, other listed references are counterparts of the foreign references noted in the body of the IDS. The Examiner is asked to consider this information and to indicate so on the record.

B. *35 U.S.C. § 112, 1st paragraph (written description)*

Claims 44-45 are rejected as failing to comply with the written description requirement. Office Action, p. 4. In particular, the Office has urged that there is no written description to support for "unsaponifiable fractions of avocado oil enriched with furan derivatives" and

“unsaponifiable fractions of avocado oil enriched with polyhydroxylated fatty alcohol derivatives.” Office action, p. 4. The Office’s position is that no one has ever analyzed such oils or has any idea what furan derivatives or polyhydroxylated fatty alcohol derivatives are. This cannot be the case.

The extraction of avocado oil from avocados is known. See U.S. patent 4,444,763, April 24, 1984. (Requested that the Examiner consider this reference.)

Nonsaponifiable matter of avocado oil is also known. U.S. patent 5,498,411. (Requested that the Examiner consider.) Indeed, this ‘411 patent is Rancurel that was relied on by the Examiner in the present Office action. Furthermore, one of the references cited in that file wrapper history is entitled “The Avocado: It’s Oil & Nonsaponifiable Matter ... Parfume Cosmetiques, Aromes,” 61 Feb.-Mar. 1985, pp. 91-95, English language translation included. Therefore, it is surprising that the Office takes the position that avocado oil components are not within the possession of those skilled in the art when avocado oil has been studied to such an extent. (The Examiner is also referred to U.S. patent No. 5,643,600, issued July 1, 1997.) Thus, the present use of descriptive words is enough for one of ordinary skill in the art to be convinced that the present inventors were in possession of the identified components of the avocado oil. The rejection should be withdrawn.

C. 35 U.S.C. § 112, 2nd paragraph

Claims 44-45 were rejected for reciting the terms “furan derivatives” (Fraction H) and “fatty alcohols” (Fraction I) as rendering the claims indefinite. The present version of the claims does not use these terms, and thus, the present rejection should be withdrawn.

D. 35 U.S.C. § 102

Claims 41-46, 48-50, 55, 59, and 65 were rejected as being anticipated by Guillon, U.S. Patent No. 4,386,067. Office action, p. 5. The present claims are not in the present application, and thus, the present rejection should be withdrawn. As to the new claims, they are based on

claims 53, 56-57, and 60, which have not been rejected for this reason, thus the present claims are believed allowable.

E. *35 U.S.C. § 103*

Claims 47, 53-54, 56-58, and 60 were rejected as obvious over the teachings of Rancurel (U.S. Patent No. 5,498,411), and Guillon (U.S. Patent No. 4,386,067). The Office action states that the method of treatment of scars and the method of cosmetic depilatory treatment only requires an application to the skin and “not ... that the skin has a scar or where the skin is hirsute.” Office Action p. 9. The present version of the claims recites “a scar” (claim 67) or “hirsute skin” (claim 68). Thus, the present version of the claims avoids this rejection, which should be withdrawn.

Conclusion

It is believed that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.


The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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